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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,263	12/31/2003	Kazuhiko Taira	247189US2SX	6584
22850 7590 11/20/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER HASAN, SYED Y	
			ART UNIT 2621	PAPER NUMBER
			NOTIFICATION DATE 11/20/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/748,263	Applicant(s) TAIRA ET AL.	
	Examiner Syed Y. Hasan	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of: .
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>03/31/2004 and 04/12/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent thereof, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent

Subject Matter Eligibility " (Official Gazette notice of 22 November 2005), Annex

IV reads as follows:

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claims 1 and 2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claims 1 and 2 define "recording medium" with descriptive material. While "functional descriptive material" may be claimed as a statutory product (i.e., a "manufacture") while embodied on a tangible computer readable medium, recording medium embodying that same functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory class of §101. Rather, "medium" is a form of energy, in the absence of any physical structure or tangible material. Examiner recommends changing "An information recording medium recording highlight

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information " to "A computer readable information recording medium recording highlight information"

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims ~~1, 2, 4 and 6~~¹⁻⁶ are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al (US 5771334) in view of Mori et al (US 2002/0110369) and further in view of Park et al (US 6724981)

Regarding **claim 1**, Yamauchi et al discloses an information recording medium recording highlight information (col 25, lines 34 – 38) for highlighting a predetermined region in a sub-picture display region (col 14, lines 11 – 15) by changing a mixture ratio between a main picture and a sub-picture of the predetermined region (col 25, lines 45 – 51)

However Yamauchi et al does not disclose wherein the highlight information describes highlight general information and a button information table, the button information table is classified into one or a plurality of groups; the highlight general information describes a button mode; and the button mode describes a flag indicating whether or not a high definition button group is recorded, the number of button groups, and a display type of a sub-picture corresponding to the button group.

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On the other hand Mori et al teaches wherein the highlight information (fig 47, 1120) describes highlight general information (1121) and a button information table (1123 and para 0291), the button information table is classified into one or a plurality of groups;(fig 55) the highlight general information describes a button mode;(fig 47, para 0291) and the button mode describes a flag (para 0153 illustrates a flag) indicating whether or not a button group is recorded (para 0232 illustrates recording with respect to a flag) the number of button groups (fig 33) and a display type of a sub-picture corresponding to the button group (para 0221 illustrates sub-picture corresponding to button group and para 0291 illustrating button command)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate wherein the highlight information describes highlight general information and a button information table , the button information table is classified into one or a plurality of groups; the highlight general information describes a button mode; and the button mode describes a flag indicating whether or not a high definition button group is recorded, the number of button groups, and a display type of a sub-picture corresponding to the button group as taught by Mori et al in the system of Yamauchi et al in order to realize reproduction of high quality digital audio data along with video data in a restricted range of bit rates at a relatively low cost.

The combination of Yamuchi et al and Mori et al does not teach a high definition device.

On the other hand Park et al teaches a high definition device (col 10, lines

34 – 39)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a high definition device as taught by Park et al in the combined system of Mori et al and Yamauchi et al in order to provide better quality of image and sound of the DVD information to the user.

Regarding **claim 2**, Yamauchi et al discloses an information recording medium (see claim 1 above)

However Yamauchi et al and Park et al do not discloses the button information table describes a maximum of 36 items of button information; and the maximum of 36 items of button information are described in a 1-group mode formed of 36 items of the button information, a 2-group mode, each of the two groups is formed of 18 items of button information, or a 3-group mode, each of the three groups is formed of 12 items of button information.

On the other hand Mori et al teaches the button information table describes a maximum of 36 items of button information; and the maximum of 36 items of button information are described in a 1-group mode formed of 36 items of the button information, a 2-group mode, each of the two groups is formed of 18 items of button information, or a 3-group mode, each of the three groups is formed of 12 items of button information (fig 55 displays initial button number, but this could go to any number as shown in fig 52, #1 to #j and could be described in 2 groups as shown or in 3 groups)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the button information table describes a maximum of

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36 items of button information; and the maximum of 36 items of button information are described in a 1-group mode formed of 36 items of the button information, a 2-group mode, each of the two groups is formed of 18 items of button information, or a 3-group mode, each of the three groups is formed of 12 items of button information as taught by Mori et al in the combined system of Park et al and Yamauchi et al in order to describe a stream number of a sub-picture used in the picture program.

Regarding **claim 3**, Yamauchi et al, Mori et al and Park et al disclose an information playback apparatus used for an information recording medium recording highlight information for highlighting a predetermined region in a sub-picture display region by changing a mixture ratio between a main picture and a sub-picture of the predetermined region, wherein the highlight information describes highlight general information and a button information table; the button information table is classified into one or a plurality of groups; the highlight general information describes a button mode; and the button mode describes a flag indicating whether or not a high definition button group is recorded, the number of button groups, and a display type of a sub-picture corresponding to the button group (rejected based on claim 1 above and the abstract, for playback i.e. reproducing)

However, Yamauchi et al does not disclose the information playback apparatus comprising: means for reading out the flag and the display type from the information recording medium; means for, when the flag indicates that a high definition button group is recorded, displaying the read-out button

information with high definition, and when the flag indicates that a high definition button group is not recorded, displaying the read-out button information according to the display type.

On the other hand Mori et al teaches the information playback apparatus comprising: means for reading out the flag (para 0153 illustrates a flag) and the display type from the information recording medium (para 0420 illustrates variety of displays) means for, when the flag indicates that a button group is recorded (para 0232 illustrates recording on the disk) displaying the read-out button information (fig 40) and when the flag indicates that a button group is not recorded, displaying the read-out button information according to the display type (para 0256 and fig 50 para 0305)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the information playback apparatus comprising: means for reading out the flag and the display type from the information recording medium means for, when the flag indicates that a button group is recorded, displaying the read-out button information, and when the flag indicates that a button group is not recorded, displaying the read-out button information according to the display type as taught by Mori et al in the system of Yamauchi et al in order to realize reproduction of high quality digital audio data along with video data in a restricted range of bit rates at a relatively low cost.

The combination of Yamuchi et al and Mori et al does not teach a high definition device.

On the other hand Park et al teaches a high definition device (col 10, lines 34 – 39)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a high definition device as taught by Park et al in the combined system of Mori et al and Yamauchi et al in order to provide better quality of image and sound of the DVD information to the user.

Claims 4 and 6 are rejected based on claim 2 above.

Claim 5 is rejected based on claim 3 above

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

Fuchigami et al (US 6788880) discloses a recording medium having a first area for storing an audio title set and a second area for storing a still picture set and apparatus for processing the recorded information.

Denda et al (US 7061838) discloses an apparatus and method for caching and selectively reproducing information from recording media.

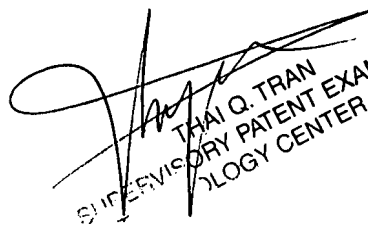
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.Y.H.
11/09/2007


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